

Application No.: 10/622,445
Atty. Docket No.: 54525.000102

Reply to Office Action of July 23, 2004

Remarks

At the time of the Office action, claims 1-7 were pending in the application. Claims 1 and 6 were rejected in the Office action under 35 U.S.C. § 103. Claims 2-5 and 7 were objected to as depending from a rejected base claim.

This amendment cancels claim 1 and amends claims 2, 6, and 7. Additionally, new claims 8-12 have been added. With the entry of this amendment, claims 2-12 are now pending in the application.

Claim 1. Claim 1 is canceled.

Claim 2. Claim 2 was objected to as depending from rejected claim 1 with the indication that claim 2 would be allowable if rewritten in independent form including all the limitations of the base claim. Claim 2 is amended to include all the limitations of base claim 1. Applicants, therefore, respectfully request the allowance of claim 2.

Claims 3-5 and 7. Claims 3-5 and 7 were objected to as depending from rejected base claim 1. Claim 1 is canceled and claims 3-5 and 7 now depend from allowable base claim 2. Applicants respectfully request the allowance of claims 3-5 and 7.

Claim 6. Claim 6 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious in view of U.S. Patent 5,165,173 to Miller ("Miller"). Claim 6 originally depended from rejected claim 1 but is now amended to depend from allowable claim 2. Because claim 6 depends from allowable claim 2, claim 6 contains all the limitations of claim 2. Therefore, Applicants

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respectfully traverse the rejection of claim 6 and request that the rejection of this claim be withdrawn.

Claim 8. Claim 8 is new. It contains all the recitations of canceled claim 1 with the additional recitation that "the bearing is axially aligned with the bore." This additional recitation distinguishes claim 8 over Miller. Miller does not show a device in which a bearing is axially aligned with the bore. In fact, Miller does not show a bearing at all, but instead shows a "screw rotating member." Miller, col. 5, ll. 24-25. Applicants respectfully contend that it would not have been obvious to one of ordinary skill in the art to use the screw rotating member instead of a bearing. But even if for the sake of argument it would have been obvious to one of ordinary skill in the art to employ a bearing in the place of the screw rotating member, it certainly would not have been obvious from Miller to axially align the bearing with the bore. The Miller device is functional only when the screw rotating member is offset within the bore. If the screw rotating member was axially aligned with the bore, the Miller device would cease to function altogether.

If the proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). Here, if the screw rotating member of Miller were modified to have a bearing that was axially aligned with the bore, the Miller device would not function. For at least this reason, Miller does not render obvious the recitation of claim 8 that "the bearing is axially aligned with the bore." Applicants respectfully request the allowance of claim 8.

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Claims 9-12. Claims 9-12 are new. They depend from claim 8 and are allowable for at least the reasons that claim 8 is allowable.

Applicants believe that all of the rejections and objections in the Office action have been addressed by the amendments and remarks above. If there are any questions regarding this Response, Applicants welcome a telephone call or interview with the undersigned Applicants' representative.

If any additional fees are due, the Commissioner is authorized to debit those fees from the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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